Supreme Court, U.S.
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No. 99-1571

IN THE

Supreme Court of the United States

TRAFFIX DEVICES, INCORPORATED,
Petitioner,

v.

MARKETING DISPLAYS, INCORPORATED,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit

BRIEF FOR PETITIONER

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QUESTION PRESENTED

Whether federal trade dress protection extends to a product configuration—such as the one at issue in this case—covered by an expired utility patent.

PARTIES TO THE PROCEEDING AND RULE 29.6 STATEMENT

The caption contains the names of all parties that appeared in the Sixth Circuit. Petitioner TrafFix Devices, Inc. has no parent companies or subsidiaries.

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Sarkisian v. *Winn-Proof Corp.*, 697 F.2d 1313 (9th Cir.), *cert. denied*, 460 U.S. 1052 (1983) 6,22,23
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Sears, Roebuck & Co. v. *Stiffel Co.*, 376 U.S. 225 (1964) ..... *passim*
Singer Mfg. Co. v. *June Mfg. Co.*, 163 U.S. 169 (1896) ..... *passim*

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Tennessee Valley Auth. v. *Hill*, 437 U.S. 153 (1978) 29
Thomas & Betts Corp. v. *Panduit Corp.*, 935 F. Supp. 1399 (N.D. Ill. 1996), *rev'd*, 138 F.3d 277 (7th Cir.), *cert. denied*, 525 U.S. 929 (1998) 37,41,42,43
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Wal-Mart Stores, Inc. v. *Samara Bros., Inc.*, 120 S. Ct. 1339 (2000) 4,11,26,42,43
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U.S. Const. art. I, § 8, cl. 8 ..... *passim*

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S. Rep. No. 100-515 (1988) 30
H.R. Rep. No. 106-250 (1999) 30

Other:

Elizabeth Fleet, *Madison's "Detached Memoranda,"* 3 Wm. & Mary Q. 534 (1946) 15
Felix Frankfurter, *Some Reflections on the Reading of Statutes*, 47 Colum. L. Rev. 527 (1947) 28

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Todd R. Geremia, *Protecting the Right to Copy: Trade Dress Claims for Configurations in Expired Utility Patents*, 92 Nw. U. L. Rev. 779 (1998) 37,42
J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* (4th ed. 1996) 8,9,26,27,39
J. Thomas McCarthy, *Lanham Act § 43(a): The Sleeping Giant Is Now Wide Awake*, 59 Law & Contemp. Probs. 45 (1996) 42
Willajeanne F. McLean, *Opening Another Can of Worms: Protecting Product Configuration as Trade Dress*, 66 U. Cin. L. Rev. 119 (1997) 26
Peter Meinhardt, *Inventions, Patents & Monopoly* (London 1946) 13
Kevin E. Mohr, *At the Interface of Patent and Trademark Law: Should a Product Configuration Disclosed in a Utility Patent Ever Qualify for Trade Dress Protection?*, 19 Hastings Comm. & Ent. L.J. 339 (1997) 30,31,40
Beverly W. Pattishall, *The Constitutional Foundations of American Trademark Law*, 78 Trademark Rptr. 456 (1988) 25
Herbert F. Schwartz, *Patent Law & Practice* (2d ed. 1995) 16
The Republic of Letters (James Morton Smith ed. 1995) 14
Restatement (Third) of Unfair Competition (1995) 26
Edward C. Walterscheid, *Patents & Manufacturing in the Early Republic*, 80 J. Pat. & Trademark Off. Soc'y 855 (1998) 12
Webster's II New University Dictionary (1994) 30

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BRIEF FOR PETITIONER

OPINIONS BELOW

The opinion of the Sixth Circuit is reported at 200 F.3d 929 and reproduced in the appendix to the petition for certiorari ("Pet. App.") at 1a. The June 2, 1997 opinion of the District Court for the Eastern District of Michigan is reported at 967 F. Supp. 953 and reproduced at Pet. App. 68a. The June 12, 1997 opinion of the District Court is reported at 971 F. Supp. 262 and reproduced at Pet. App. 25a.

JURISDICTION

The judgment of the Sixth Circuit was entered on December 29, 1999. Pet. App. 1a. The jurisdiction of the Sixth

Circuit was based on 28 U.S.C. §§ 1291 and 1292(a)(1). This Court has jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Patent Clause of the United States Constitution grants Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. art. I, § 8, cl. 8.

Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), provides in part:

> (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
>
> (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person * * *
>
> shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

The full text of Section 43(a) and other pertinent statutory provisions are reprinted in the addendum to this brief.

INTRODUCTION

Our patent system rests on a "carefully crafted bargain." *Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-151 (1989). An inventor "who is willing to reveal to the public the substance of his discovery" may obtain, in the form of a patent, a limited "right to exclude others from

making, using, or selling the invention." *Id.* at 150 (quotations omitted). But once the patent expires, "the invention inures to the people, who are thus enabled without restriction to practice it and profit by its use." *Id.* at 151 (same). The bargain—viewed by the Framers as vital to fostering invention in the new Republic without stifling competition—is guarded by the Constitution, which, while authorizing Congress to grant patents, provides that they must be for "*limited* Times." U.S. Const. art. I, § 8, cl. 8 (emphasis added). To enforce this bargain, this Court has "long held that after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public as a matter of federal law." *Bonito Boats*, 489 U.S. at 152.

In this case, it is necessary for the Court, again, to enforce the patent bargain, and ensure that the public's right to copy and use the subject of expired patents is not thwarted. Respondent manufactures and sells a highway traffic sign stand that for years enjoyed utility patent protection. During this period, respondent successfully enforced its patent monopoly to prevent the competition from using its invention and selling a virtually identical sign stand. Then respondent's patents expired. At that point, petitioner sought to manufacture a traffic sign stand with the same basic configuration as the one utilized by respondent and covered by its expired patents, but with certain improvements that petitioner eventually patented. No longer armed with its patent monopoly, respondent brought this action to enjoin the sale of petitioner's sign stand under Section 43(a) of the Lanham Act, claiming that petitioner had infringed respondent's "trade dress" in the form of the patented device itself.

Compared to patent law, federal trade dress law is of recent vintage and stands on a different constitutional footing. Federal trade dress law has evolved only over the past few decades and largely as a result of judicial interpretation of the Lanham Act—a product of the exercise of Congress' general Commerce Clause authority. The concept of protectible

trade dress "originally included only the packaging, or 'dressing,' of a product, but in recent years has been expanded by many courts of appeals to encompass the design of a product" and, at its extreme, even just a product's shape or configuration. *Wal-Mart Stores, Inc.* v. *Samara Bros., Inc.*, 120 S. Ct. 1339, 1342 (2000). The basic question in this case is whether, or under what circumstances, federal trade dress protection extends under the Lanham Act to a product configuration that is the subject of an expired utility patent.

The resolution of this issue has profound consequences for the patent bargain, the public's right to copy from expired patents, and a patent system that has proven to be one of the most successful engines ever devised for promoting scientific innovation without impeding the sort of "imitation and refinement through imitation" that is "the very lifeblood of a competitive economy." *Bonito Boats*, 489 U.S. at 146.

STATEMENT OF THE CASE

Respondent Marketing Displays, Inc. ("MDI") has manufactured and sold a commercially successful traffic sign stand since the mid-1970s under the registered trademark WINDMASTER. WINDMASTER traffic sign stands—used to display signs such as ROAD WORK AHEAD—have a single upright attached to four legs, with a narrowly spaced, dual-spring base connecting the upright to the legs. *See* Appendix ("App.") 1a. Due to the operation of the dual-spring base in conjunction with other components of the device, the sign stand is able to stay upright in windy conditions and deflect blows from oncoming traffic. The discovery that is the basis for the sign stand's success was conceived by MDI's president, Robert Sarkisian, in the mid-1960s and is the subject of two utility patents issued by the United States Patent and Trademark Office ("PTO")—U.S. Patent Numbers 3,646,696 and 3,662,482, or the '696 and '482 patents. The last of these patents expired in 1989, 17 years after it was issued. Pet. App. 2a-3a, 26a-27a.

Utility patents may be issued for any novel, useful, and nonobvious process, machine, manufacture, or composition of matter. *See* 35 U.S.C. §§ 101-103. They secure a limited monopoly on the use of the invention, expressed in terms of "the right to exclude others from making, using, offering for sale or selling the invention throughout the United States" during the life of the patent. *Id.* § 154(a)(1). MDI's patents claim a "display device comprising an unanchored base" and spaced-apart "ground-engaging means"—what we would call legs—with "a spring structure mounting the frame structure onto the base, said spring structure comprising spring means connected at least at two spaced apart locations between the lower end of the frame structure and the base." '482 Patent, L49; '696 Patent, L44.[1] They also set forth the basic formula according to which the device functions, which, among other things, limits placement of the dual-spring base in relation to other elements of the stand and its center of gravity. *See* '482 Patent, L50; '696 Patent, L43; J.A. 181, 183-184.

The file history of MDI's patents touts the utilitarian significance of the stand's unique, dual-spring base:

> One of the novel points of structure in the present invention is the provision of a pair of spring connections as opposed to a single spring connection[.] * * * The reason for providing two spaced apart spring connections is to force the sign to deflect in a direction along the longitudinal axis of the base and to prevent twisting of the sign frame. Thus, it is not a matter of choice whether one or two springs are used in [the] invention. [*See* J.A. 220 (File History of '696 Patent).]

During the life of the patents, MDI advertised its traffic sign stands and labeled them as being "[c]overed by" the

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[1] The '696 and '482 patents, along with various other record materials containing diagrams or photographs, are included in the parties' Rule 32 Lodging, cited as "L__."

'696 and '482 patents. L85 (MDI brochure); *see* L56, L75, L81, L91; J.A. 208. In addition, MDI enforced its patent monopoly by enjoining a competitor (Winn-Proof) from selling a "spring mounted sign stand" virtually identical to MDI's traffic sign stand. *Sarkisian* v. *Winn-Proof Corp.*, 697 F.2d 1313, 1316 (9th Cir.), *cert. denied*, 460 U.S. 1052 (1983). *See id.* at 1315; App. 1a. In upholding the injunction, the Ninth Circuit observed that the dual-spring base is a "crucial element[]" of the device, and agreed with the district court "that the pair of springs used in the accused sign stand was the equivalent of the pair of 'spaced apart' coil springs described in the claims of Sarkisian's '696 patent." 697 F.2d at 1319-20 n.15, 1322. The court similarly found that both MDI's and Winn-Proof's sign stands "utilize[d]" the invention described in the patents "in fashioning the bases of their respective devices" and, thus, "function[] in precisely the same way" as the patented invention. *Id.* at 1322.

MDI's patents expired in 1989. TrafFix's president, an inventor with several patents in his own right, knew that MDI's patents had expired, and understood that after expiration of a patent the subject matter of the patent enters the public domain. TrafFix accordingly arranged to reengineer a traffic sign stand utilizing the same basic configuration—a dual-spring base attached to four spaced-apart legs and an upright—that is covered by the '696 and '482 patents and is the reason the sign stand is so stable. At the same time, however, TrafFix sought to improve MDI's product. Thus, for example, TrafFix developed and eventually patented (U.S. Patent Number 5,611,509) a step-and-drop leg that eliminates the need to bend over and release each leg individually, as is required in operating MDI's sign stand. In addition, TrafFix made improvements (also later patented) in the brackets used to display signs on its stand. TrafFix's version of the popular dual-spring sign stand bears the TrafFix label. *See* Pet. App. 3a; J.A. 252-253.

TrafFix brought its sign stand to market in 1994, and began selling it the following year under the WINDBUSTER mark. Pet. App. 3a-4a.[2] Just as it had done in the case of Winn-Proof, MDI moved to block TrafFix's entry into the market. But this time—since its patent monopoly had expired—MDI turned to federal trademark law. In July 1995 MDI filed this action under the Lanham Act, claiming that TrafFix's use of the WINDBUSTER mark infringed its WINDMASTER mark; that TrafFix's use of the basic configuration utilized by MDI's traffic sign stand infringed MDI's unregistered trade dress; and that TrafFix had thereby engaged in unfair competition. TrafFix counterclaimed, and both parties moved for summary judgment. On January 13, 1997, the District Court granted summary judgment for MDI on the trademark claim, and issued an amended opinion in support of its order on June 2, 1997. *Id.* 4a, 68a. On June 12, 1997, the District Court granted summary judgment for TrafFix on MDI's trade dress and unfair competition claims. *Id.* 4a, 25a.

In support of its trade dress infringement claim—the only claim at issue here—MDI touted what it described as the "unique and distinctive dual-spring design" of its sign stand. MDI's Mem. In Supp. Of Its Mot. For Summ. J. That Def.'s Spring-Mounted Sign Stands Infringe MDI's Trade Dress Rights, Dkt. No. 70, at 1-2. It similarly argued that, "[d]ue to the long period of exclusive use" (as a result of the expired patents) and promotional efforts during that period, people "associate MDI's product configuration—the dual-spring design—with MDI." *Id.* 3. *See also id.* ("The dual-spring design of MDI's * * * sign stands has become so widely known that people immediately associate the dual spring design with MDI."); MDI's Reply To TrafFix's Br. In Opp. To MDI's Mot. For Summ. J., Dkt. No. 88, at 3 (arguing that

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[2] TrafFix applied for registration of the WINDBUSTER mark in 1994. The PTO allowed the application and issued a registration in 1996, after the requisite notice period. *See* Pet. App. 3a-4a.

alleged trade dress is strong on the ground that "those in the industry have come to associate the look of the dual spring design as coming from MDI"); Pet. App. 29a & n.6, 60a.

In rejecting MDI's trade dress claim, the District Court began with the "well established [rule] that in the case of an expired patent, the federal patent laws * * * create a federal right to 'copy and use.' " *Id.* 46a-47a (quoting *Bonito Boats*, 489 U.S. at 165). The court also observed that " 'one cannot argue that a shape is functionally advantageous in order to obtain a utility patent and later assert that the same shape is non-functional in order to obtain trademark protection.' " *Id.* 49a (quoting 1 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 7:89 (4th ed. 1996)). Against this backdrop, the District Court viewed the "expired utility patents [as] especially strong evidence of the usefulness of the dual-spring design"—"the most *utilitarian* aspect of MDI's sign stands"—and held that the alleged "trade dress is functional as a matter of [trademark] law," and thus not protected by the Lanham Act. *Id.* 55a (emphasis in original).[3] In so holding, the District Court also concluded that cloaking MDI's product configuration with trade dress protection would hinder competition. *Id.* 54a.

The Sixth Circuit affirmed the District Court ruling on the trademark infringement claim, but reversed as to trade dress. With respect to the latter claim, the Court of Appeals acknowledged that "[a] circuit split exists as to whether a utility patent disclosure forecloses trade dress protection." *Id.* 18a. "The Fifth, Seventh, and Federal Circuits have held or

[3] The District Court found "untenable" MDI's argument that the expired patents did not sufficiently disclose the configuration of MDI's traffic sign stand, or the alleged trade dress, given that "MDI has, in the past, enforced its rights in its * * * patents by enjoining the manufacture of a product configuration *virtually identical* to that being alleged to constitute trade dress in the instant case." Pet. App. 49a (emphasis added).

strongly suggested that a utility patent disclosure does not prevent trade dress protection." *Id.* But "the Tenth Circuit * * * has held that '[w]here a product configuration is a significant inventive component of an invention covered by a utility patent * * * it cannot receive trade dress protection under section 43(a).' " *Id.* 19a (quoting *Vornado Air Circulation Sys., Inc.* v. *Duracraft Corp.*, 58 F.3d 1498, 1500 (10th Cir. 1995), *cert. denied*, 516 U.S. 1067 (1996)). The Sixth Circuit then dismissed the Tenth Circuit position—which is grounded on "the public policy underlying patent law of releasing protected designs 'after a period of time"—and, instead, aligned itself with the circuits allowing federal trade dress protection in this context. *Id.*

In particular, the Sixth Circuit concluded that the District Court should have applied "a functional analysis of the trade dress *unencumbered by any presumptions*" stemming from the expired patents and, instead, focused on whether use of "the particular product configuration is a competitive necessity." *Id.* 19a-20a (emphasis added). The court also criticized the District Court for focusing on the utility of the configuration covered by the expired patents, rather than the product's "entire look." *Id.* 19a. Even though the dual-spring base is the only component that distinguishes MDI's sign stands from the competition—"every other competitor uses the other elements of a single upright, four leg members extending out at angles, and a sign"—the Sixth Circuit held that the expired utility patents covering this configuration did not preclude trade dress protection. *Id.* 20a.

This Court granted certiorari. 120 S. Ct. 2715.

SUMMARY OF ARGUMENT

To promote the progress of useful arts, the patent system is built around a simple concept, or bargain: in exchange for the limited monopoly conferred by a patent, the public is entitled to copy and use the subject of the patent when it expires. This bargain is embodied in our Constitution and

patent laws. To enforce it, this Court has long held that "on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property." *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U.S. 169, 185 (1896). That includes "the right to make the machine in the form in which it was constructed during the patent." *Id.* The Court has repeatedly reaffirmed this principle and, in particular, held that trademark and unfair competition law may not be applied to defeat the public's right to copy from expired patents in the name of protecting against consumer confusion. Under these settled principles, the public's right to copy plainly extends to the product configuration in this case—the dual-spring sign stand that is the subject of MDI's expired utility patents.

The question presented is whether the law of federal trade dress—found in Section 43(a) of the Lanham Act—trumps the public's right to copy in these circumstances. It does not, and could not. To begin with, Congress has expressed no intent to repeal, or even just curtail, the public's right to copy from expired patents. Just the opposite. One of the purposes of the Lanham Act was to codify the common law of trademark and unfair competition; a settled feature of that law—carved by decisions like *Singer*—was that it could not be invoked to prevent the copying of a product configuration that is the subject of an expired patent. Moreover, as this Court has recognized, *Qualitex Co.* v. *Jacobson Prods. Co.*, 514 U.S. 159, 164-165 (1995), and Congress recently made express, the Lanham Act does not confer trade dress protection on "functional" products or features. 15 U.S.C. § 1125(a)(3). By definition, a device that qualifies for utility patent protection is "useful" and, at least in a lay sense, functional. 35 U.S.C. § 101. And for most if not all utility-patented devices—including the dual-spring sign stand involved in this case—function dictates form.

A contrary construction would raise grave constitutional concerns. Because of the Constitution's "limited Times"

proviso, "Congress may not create patent monopolies of unlimited duration." *Bonito Boats*, 489 U.S. at 146. It may not do so by creating timeless patents, and it may not do so by cloaking the subject of expired patents with perpetual trade dress protection. The Court has already recognized that States may not attempt to continue the patent "monopoly by resorting to trademark law," *Scott Paper Co.* v. *Marcalus Mfg. Co.*, 326 U.S. 249, 256 (1945); Congress is no more free to do so. Trademark law is a product of Congress' general Commerce Clause power, which, while far-reaching, does not authorize Congress to override other provisions of the Constitution. Congress retains leeway to protect against consumer confusion caused by the similarity of goods by requiring producers, for example, to label their own goods or use distinctive packaging. But it may not prevent the public from copying a product that is the subject of an expired patent; that would "substantially," and thus impermissibly, upset the patent bargain. *Bonito Boats*, 489 U.S. at 167.

The public's right to copy from expired patents should not be subordinated to a factbound inquiry—dressed in terms of functionality—into whether there is a "competitive need" to copy a particular configuration, at a particular point in time, in a particular market. This inquiry is not supported by this Court's trademark decisions, let alone a common sense construction of functionality. And it is a recipe for confusion, litigation, and the equally disruptive threat of litigation. As this Court recently recognized, "[c]ompetition is deterred * * * not merely by successful suit but by the plausible threat of successful suit." *Wal-Mart Stores, Inc.* v. *Samara Bros., Inc.*, 120 S. Ct. at 1345. Under an indeterminate, "competitive need" functionality regime, virtually no producer could rule out expensive Lanham Act litigation (or liability) for copying the subject of an expired patent. This would not only stifle the kind of "imitation and refinement through imitation" this Court has called "the very lifeblood of a competitive economy," but would discourage activity "nec-

essary to invention" itself. *Bonito Boats*, 489 U.S. at 146. Not to mention that there is no exception to the Constitution's "limited Times" provision based on the purported lack of competitive need for the public to use the subject of a particular patent.

Instead of embracing this indeterminate and counterintuitive concept of functionality, the Court should adhere to the clear, predictable rule it has applied for more than a century: "after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public as a matter of federal law." *Id.* at 152. That includes the subject matter of MDI's expired patents and, thus, the dual-spring sign stand that was the subject of the *Winn-Proof* litigation, and is now at issue here. The judgment below should be reversed.

ARGUMENT

I. AS THIS COURT HAS REPEATEDLY RECOGNIZED, THE PATENT SYSTEM ESTABLISHES A PUBLIC RIGHT TO COPY AND USE THE SUBJECT OF EXPIRED PATENTS.

A. The Patent System Was Founded To Bring Discoveries Into The Public Domain And Thus Promote The Progress Of Useful Arts.

"To promote the progress of useful arts, is the interest and policy of every enlightened government," and the Framers appreciated that it was in the interest of ours. *Grant* v. *Raymond*, 31 U.S. (6 Pet.) 218, 241 (1832) (Marshall, C.J.). *See* Edward C. Walterscheid, *Patents & Manufacturing in the Early Republic*, 80 J. Pat. & Trademark Off. Soc'y 855, 860-861 (1998). In establishing our National Charter, the Framers—on James Madison's motion in 1787—specifically empowered Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. art. I, § 8, cl. 8. While little discussion was devoted to the Patent Clause during the

debates on the Constitution, there has never been any serious dispute on this Court as to its import or meaning.

"The clause is both a grant of power and a limitation." *Graham* v. *John Deere Co.*, 383 U.S. 1, 5 (1966). It authorizes Congress to grant patents—"an equivalent form of monopoly"—in discoveries. *Id.* at 7. But at the same time, it limits that authority in significant respects. First, the authority must be exercised in furtherance of "the stated constitutional purpose," *id.* at 5-6—promotion of science and useful arts. "This is the *standard* expressed in the Constitution and it may not be ignored." *Id.* (emphasis in original). *See United States* v. *Steffens (The Trade-Mark Cases)*, 100 U.S. 82, 93-94 (1879); *Kendall* v. *Winsor*, 62 U.S. (21 How.) 322, 328 (1858). Second, the authority may only be used to grant patents for "limited Times." "Congress may not create patent monopolies of unlimited duration." *Bonito Boats*, 489 U.S. at 146. *See Pennock* v. *Dialogue*, 27 U.S. (2 Pet.) 1, 16-17 (1829) (Patent Clause "contemplates" that an "exclusive right shall exist but only for a limited period") (Story, J.).

The decision to limit Congress' patent power in this fashion was by no means fortuitous. The Patent Clause "was written against the backdrop of the practices—eventually curtailed by the Statute of Monopolies—of the Crown in granting monopolies to court favorites in goods or businesses which had long before been enjoyed by the public." *Graham*, 383 U.S. at 5 (citing Peter Meinhardt, *Inventions, Patents & Monopoly* at 30-35 (London 1946)). Indeed, given this experience, not to mention the "monopoly on tea that sparked the Revolution," the founding Americans "had an instinctive aversion to monopolies." *Id.* at 7. Thomas Jefferson—who this Court has called the "moving spirit" behind our patent system, in light of "his active interest and influence in the early development of [that] system"—viewed the "limited private monopoly" conferred by a patent as nothing less than a " 'public * * * embarrass-

ment.' " *Graham*, 383 U.S. at 7, 9 (quoting Jefferson).[4] But Jefferson, like the Framers, eventually if begrudgingly came to the view that it was a necessary embarrassment.

The "limited and temporary monopoly" conferred by a patent is "at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals, and the incentive to further efforts for the same important object." *Kendall*, 62 U.S. (21 How.) at 327-328. *See Graham*, 383 U.S. at 9; *see also Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225, 229 (1964) (patents "are meant to encourage invention by rewarding the inventor with the right, limited to a term of years fixed by the patent, to exclude others from the use of his invention"); *Grant*, 31 U.S. (6 Pet.) at 241-242 (The patent "is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions.") (Marshall, C.J.). The stimulation of what Justice Story called the "efforts of genius" served the "main object" of the Patent Clause—"to promote the progress of science and useful arts." *Pennock*, 27 U.S. (2 Pet.) at 19 (quotation omitted). The patent monopoly is "merely a means to that end." *United States* v. *Masonite Corp.*, 316 U.S. 265, 278 (1942).

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[4] From his diplomatic post in France, Jefferson lobbied Madison to include in the Constitution "a Bill of Rights provision restricting monopoly." *Graham*, 383 U.S. at 7. Similarly, after learning that the Constitution had been ratified by the requisite nine States, Jefferson wrote Madison to express his delight, but added that it would be wise "to abolish * * * Monopolies, in all cases." 1 The Republic of Letters 545 (James Morton Smith ed. 1995) (July 31, 1788 Ltr. from Jefferson to Madison). Jefferson continued: "The saying there shall be no monopolies lessens the incitements to ingenuity, which is spurred by the hope of a monopoly for a limited time, as of 14. years; but the benefit even of limited monopolies is too doubtful to be opposed to that of their general suppression." *Id.*

But the patent monopoly—so at odds with America's "instinctive aversion to monopolies," *Graham*, 383 U.S. at 7—is not freely given. From the first patent laws, it has been extended only "on the condition that [the inventor] make full disclosure for the benefit of the public of the manner of making and using the invention, and that upon expiration of the patent the public be left free to use the invention." *Scott Paper Co.* v. *Marcalus Mfg. Co.*, 326 U.S. at 255. *See also Pfaff* v. *Wells Elecs., Inc.*, 525 U.S. 55, 63-64 (1998); *United States* v. *Dubilier Condenser Corp.*, 289 U.S. 178, 186-187 (1933). Thus, in defending the patent monopoly later in his life, Madison himself wrote that it was "considered as a compensation for a benefit actually gained to the community as a purchase of property which the owner might otherwise withhold from public use." Elizabeth Fleet, *Madison's "Detached Memoranda,"* 3 Wm. & Mary Q. 534, 551 (1946) (reproducing Madison's manuscript). This forms the "carefully crafted bargain" that has always underlay our patent system. *Bonito Boats*, 489 U.S. at 150-151.[5]

"To this end the law requires such disclosure to be made in the application for patent that others skilled in the art may understand the invention and how to put it to use" after the patent expires. *Dubilier Condenser*, 289 U.S. at 187 (footnote omitted). *See Bonito Boats*, 489 U.S. at 147; 35 U.S.C.

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[5] Congress has also established stringent requirements of patentability—including novelty, usefulness, and nonobviousness—to ensure that only discoveries warranting "the special inducement of a limited private monopoly" are eligible for patent protection. *Graham*, 383 U.S. at 9. *See Bonito Boats*, 489 U.S. at 147-151 (discussing statutory requirements). As the first steward of the Nation's patent system, Jefferson played an integral role in shaping those requirements. Given his natural aversion to monopolies—even when limited—it is not surprising to find that he "did not believe in granting patents for small details, obvious improvements, or frivolous devices." *Graham*, 383 U.S. at 9. Instead, he "insist[ed] upon a high level of patentability." *Id.*

§ 112. This information is the consideration for which the patent is granted, and "[a]s has been many times pointed out," it is "dedicat[ed] to the public on the expiration of the patent." *Scott Paper*, 326 U.S. at 255; *see* Part I.B, *infra*. *See also Kewanee Oil Co.* v. *Bicron Corp.*, 416 U.S. 470, 484 (1974) ("disclosure" is "the *quid pro quo* of the right to exclude"); *id.* at 480. The Patent Act's disclosure requirements serve the "ultimate goal of the patent system"—"to bring new designs and technologies into the public domain." *Bonito Boats*, 489 U.S. at 151. And, in this way, the patent laws "benefit * * * the public," "doubtless the primary object in granting and securing the [patent] monopoly" in the first place. *Kendall*, 62 U.S. (21 How.) at 327-328.

When all is said and done, the utility patent establishes a blueprint for the public to copy the invention upon expiration of the patent. As one commentator has explained:

> A utility patent consists of a cover page that lists pertinent information, a written description, and one or more claims. The written description, sometimes referred to as the specification and drawings, describes the invention, the preferred embodiment of the invention, and how to make and use it, so that the public has available the information needed to practice the invention. On expiration of the patent, the public may practice the invention freely. The claims of the patent define the metes and bounds of the patent owner's exclusive rights during the life of the patent. [Herbert F. Schwartz, *Patent Law & Practice* 7-8 (2d ed. 1995) (footnote omitted).]

The patent bargain not only has been part of our patent system from the organization of our government, it is embodied in and protected by the Constitution. It reflects the "understanding, implicit in the Patent Clause itself, that free exploitation of ideas will be the rule, to which the protection of a federal patent is the exception." *Bonito Boats*, 489 U.S. at 151. At the same time, by guaranteeing that inventions eventually inure to the public, the bargain serves the express

purpose of the Patent Clause. As Justice Story wrote, the "best" way to promote the progress of useful arts is "by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible." *Pennock*, 27 U.S. (2 Pet.) at 19. And of course, the bargain honors the constitutional command—of the utmost concern to Jefferson and others—that discoveries may only be cloaked with patent protection for "limited Times," U.S. Const. art. I, § 8, cl. 8, after which they inure to the people.

For more than two centuries, this system—firmly rooted in the Nation's Constitution, laws, and history—has successfully promoted science and the useful arts in this country, perhaps even beyond the Framers' greatest expectations.

B. This Court Has Repeatedly Affirmed That The Public Is Entitled To Copy And Use The Subject Of Expired Patents.

Consistent with this regime, this Court has "long held that after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public as a matter of federal law." *Bonito Boats*, 489 U.S. at 152; *see id.* at 165. Moreover, the Court has repeatedly emphasized that unfair competition or trademark law may not be applied in a manner that would defeat the public's right to copy and use the subject of expired patents, or create what are in effect patent monopolies of unlimited duration. As the Court put it in *Scott Paper*, 326 U.S. at 256 (emphasis added), "any attempted reservation or continuation in the patentee or those claiming under him of the patent monopoly, after the patent expires, *whatever the legal device employed*, runs counter to the policy and purpose of the patent laws." Time and again, the Court has held true to this conviction—giving effect to the fundamental bargain underlying our patent system.

In the *Singer* case, the Court, more than a century ago, confronted the same basic issue presented here. After Singer's utility patents expired, a competitor introduced a

sewing machine with the same "general external appearance" as Singer's. 163 U.S. at 170. Singer sued to enjoin the sale of the machine under state unfair competition law, arguing that it was confusingly similar to Singer's. *Id.* In considering this claim, this Court observed "that the necessary result of the existence of [Singer's] patents was to give to the Singer machines, as a whole, a distinctive character and form which caused them to be known as Singer machines"—in modern parlance, product configuration trade dress. *Id.* at 179. But the Court rejected the notion—refloated by MDI here—that a "manufacturer, on the cessation of the [patent] monopoly, [has] the right to prevent the making by another of a like machine in the form in which it was made during the life of the patents." *Id.* at 184.

As the Court explained:

> It is self-evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows, as a matter of course, that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent. [*Id.* at 185.]

Kellogg Co. v. *National Biscuit Co.*, 305 U.S. 111, 120 (1938), is to the same effect. In that case, the National Biscuit Company brought suit under state unfair competition law to enjoin Kellogg's sale of shredded wheat in the same "generally known * * * pillow-shaped form" as National Biscuit's cereal. *Id.* at 113. National Biscuit had obtained product and process patents on its shredded wheat cereal. This Court—following *Singer*—held that Kellogg had the right to copy the form of the biscuit upon expiration of the patents. Justice Brandeis wrote for the Court:

> The plaintiff has not the exclusive right to sell shredded wheat in the form of a pillow-shaped biscuit—the form in

> which the article became known to the public. That is the form in which shredded wheat was made under the basic patent. * * * Hence, upon expiration of the patents the form * * * was dedicated to the public. [*Id.* at 119-120.]

The Court concluded that Kellogg "was free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff." *Id.* at 120. Kellogg did so by selling its product in "distinctive" cartons—or packaging—that "bear prominently the Kellogg name." *Id.* at 121. Even though this result in effect allowed Kellogg to profit from the "good will" that National Biscuit had generated in the product during the life of its patents, it was "not unfair." *Id.* at 122. "Sharing in the goodwill of an article unprotected by patent or trade-mark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested." *Id.* Unfair competition law could not defeat that important public right.[6]

In *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. at 230 (emphasis added), the Court explained, again, that "when the patent expires the monopoly created by it expires, too, and the right to make the article—*including the right to make it in*

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[6] Citing *Singer* and *Kellogg*, the Court in *Scott Paper* declared in the same vein:

> By the force of the patent laws not only is the invention of a patent dedicated to the public upon its expiration, but the public thereby becomes entitled to share in the good will which the patentee has built up in the patented article or product through the enjoyment of his patent monopoly. Hence we have held that the patentee may not exclude the public from participating in that good will or secure, to any extent, a continuation of his monopoly by resorting to the trademark law and registering as a trademark any particular descriptive matter appearing in the specifications, drawings or claims of the expired patent, whether or not such matter describes essential elements of the invention or claims. [326 U.S. at 256.]

precisely the shape it carried when patented—passes to the public." The product at issue in *Sears*, along with the one in the tandem decision of *Compco Corp.* v. *Day-Bright Lighting, Inc.*, 376 U.S. 234 (1964), was the subject of a patent later found to be invalid. Nevertheless, in each case, the Court invoked the constitutional policy giving rise to the right to copy from expired patents, and held that state unfair competition law could not be applied in a manner that would "prohibit the copying of the *article itself*." *Sears*, 376 U.S. at 232-233 (emphasis added); *see Compco*, 376 U.S. at 237. That result would impermissibly "interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes." 376 U.S. at 237. If anything, the public's right to copy an article is only stronger where—as in this case, and in *Singer* and *Kellogg*—it has enjoyed patent protection and, therefore, the public has conferred a patent monopoly upon the inventor *in exchange for* the right to copy the product upon expiration of the patent. That is the essence of the patent bargain.

Bonito Boats underscores the continuing vitality of the *Singer* line. There, the Court held unconstitutional a state law making it unlawful to use a particular process to duplicate an unpatented boat hull—thereby extending indefinite protection "for subject matter for which patent protection has been denied *or has expired*." 489 U.S. at 159 (emphasis added). As the Court explained, the law at issue "substantially restrict[ed] the public's ability to exploit ideas that the patent system mandates shall be free for all to use," and thus intolerably altered the "careful balance" underlying the federal patent system. *Id.* at 167. In so holding, the Court was "troubled" by the lower court's statement that "the patent laws say 'nothing about the right to copy or the right to use.' " *Id.* at 164 (quoting decision). "For almost 100 years," the Court admonished, "it has been established that in the case of an expired patent, the federal patent laws *do* create a federal right to 'copy and to use.' " *Id.* at 165

(emphasis in original). Cases such as *Singer*, *Kellogg*, *Sears*, and *Compco*—on which the *Bonito Boats* Court specifically relied, *see id.* at 152-153—are a testament to that.[7]

C. The Public's Right To Copy And Use The Subject Of Expired Patents Extends To MDI's Patented, Dual-Spring Sign Stand.

There can be little doubt that—at least from this patent perspective—the public's right to copy and use the subject of expired patents extends to the product configuration in this case. MDI obtained utility patent protection for its dual-spring sign stand, arguing successfully that the product met the stringent requirements of patentability, including "useful[ness]." 35 U.S.C. § 101. In exchange for the disclosures made in its patent applications, the public granted MDI a 17-year monopoly on the use of its discovery. During this period, MDI was free to reap the benefits of its patent monopoly—and did so. MDI labeled and advertised its sign stand as being covered by the '696 and '482 patents (discouraging competition); successfully enforced those patents in the *Winn-Proof* litigation to enjoin the sale of a sign stand "virtually identical" to the one made by TrafFix (eliminating competition), Pet. App. 49a; and achieved great commercial success in the traffic sign stand market. But when MDI's patents expired, as all patents eventually must, MDI had to live up to its end of the bargain.

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[7] The Court has affirmed the public's right to copy from expired patents in numerous other cases, too. *See, e.g., Dubilier Condenser*, 289 U.S. at 187 ("upon expiration of [the patent], the knowledge of the invention enures to the people, who are thus enabled without restriction to practice it and profit by its use"); *Coats* v. *Merrick Thread Co.*, 149 U.S. 562, 572 (1893) ("[P]laintiffs' right to the use of the embossed periphery expired with their patent, and the public had the same right to make use of it as if it never had been patented.").

Just as in the case of Singer's sewing machine or National Biscuit's cereal biscuit, MDI's invention entered the public domain, and there "passe[d] to the public the right to make [it] in the form in which [MDI's sign stand] was constructed during the patent[s]." *Singer*, 163 U.S. at 185. *See also Sears*, 376 U.S. at 230 (upon expiration of the patent, the public has "the right to make the article * * * in precisely the shape it carried when patented"); *Kellogg*, 305 U.S. at 119-120 (same). That includes the right to copy and use the narrowly spaced, dual-spring base of MDI's traffic sign stand, as well as the overall configuration of the mechanical device that is the subject of MDI's utility patents. Indeed, the formula according to which MDI's sign stand functions limits the configuration of the components of the sign stand in relation to one another, restricting the overall form that the device may take and still achieve the patented function of staying upright in windy conditions. *See supra* at 5.

The *Winn-Proof* litigation underscores that the product configuration at issue here is covered by MDI's expired utility patents. As discussed, MDI successfully argued in that litigation that a sign stand essentially identical in appearance and function to MDI's traffic sign stand—and to TrafFix's sign stand—infringed MDI's patents. *See* App. 1a. As MDI argued in that case, the MDI and accused Winn-Proof traffic sign stands, while not identical to the sign stand pictured in those patents, "contain substantially the same elements, perform in substantially the same manner, and achieve substantially the same results as the Sarkisian invention." J.A. 240. Indeed, MDI claimed that the accused sign stands "were slavish copies, from the standpoint of function, of the sign stand *described and claimed* in the Sarkisian patents." *Id.* 236 (emphasis added). *See id.* 183. The Ninth Circuit agreed, concluding that Winn-Proof's dual-spring sign stands "achiev[ed] the same results in precisely the same manner" as the device disclosed in MDI's patents, and, thus, infringed those patents. 697 F.2d at 1323.

In so holding, the Ninth Circuit applied the "doctrine of equivalents." *See id.* at 1321-22. Under this fixture of patent law, it is said that "the substantial equivalent of a thing * * * is the same as the thing itself," such "that if two devices do the same work, in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape." *Machine Co.* v. *Murphy*, 97 U.S. 120, 125 (1877) (citation omitted). *See Warner-Jenkinson Co.* v. *Hilton Davis Chem. Co.*, 520 U.S. 17, 40-41 (1997); *Winans* v. *Denmead*, 56 (15 How.) U.S. 330, 341 (1853). This doctrine ensures that producers cannot avoid patent infringement by altering the "literal detail[s]" of an invention while nevertheless achieving the same results of the invention in the same way. *Graver Tank & Mfg. Co.* v. *Linde Air Prods. Co.*, 339 U.S. 605, 607 (1950). To permit such "imitation of a patented invention * * * would be to convert the protection of the patent grant into a hollow and useless thing." *Id.* That, in turn, "would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system." *Id.*[8]

At a minimum, the public's right to copy and use the subject of expired patents is coextensive with the scope of the patent monopoly bestowed upon the inventor. Otherwise, the public would be giving more than it gets, fundamentally altering the nature of the bargain underlying our patent system. Accordingly, in this case, the *Winn-Proof* litigation establishes beyond doubt that when MDI's patents expired,

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[8] Of course, the "*form* in which [a product] was constructed during the patent," *Singer*, 163 U.S. at 185 (emphasis added), will invariably be the equivalent (or closer) of the invention disclosed in the patent. Otherwise, an inventor would not be able to enforce its patent monopoly to enjoin the sale of equivalent products during the patent period, negating the principal incentive for seeking patent protection in the first place. That was true of the products at issue in *Singer* and *Kellogg* and—as the *Winn-Proof* litigation establishes—it is true of the product at issue here.

the public acquired the right to copy and use the dual-spring sign stands involved in that case—which are "virtually identical" to the one at issue here. Pet. App. 49a; App. 1a. That conclusion may be arrived at either by looking to the form in which the invention was practiced during the patent, as this Court did in *Singer* and *Kellogg*, or to the invention claimed and disclosed by MDI in obtaining patent protection in the first place. As explained next, the law of federal trade dress does not—and could not—alter this conclusion.

II. FEDERAL TRADE DRESS LAW DOES NOT—AND COULD NOT—DEFEAT THE PUBLIC'S RIGHT TO COPY AND USE PRODUCT CONFIGURATIONS THAT ARE THE SUBJECT OF EXPIRED PATENTS.

A. Product Configuration Trade Dress Lacks The Constitutional And Historical Footing Of The Public's Right To Copy From Expired Patents.

Compared to patent law, federal trade dress law—an offshoot of trademark law—is of relatively recent origin, and stands on a different constitutional footing. The first federal trademark act was not passed until 1870. It established a means of trademark registration, but was short-lived. In *The Trade-Mark Cases*, 100 U.S. at 93-94, this Court held that the Act was unconstitutional as an exercise of Congress' patent power. As the Court explained, "[t]he ordinary trademark has no necessary relation to invention or discovery. * * * It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation." *Id.* at 94. Thus, the Court held that the legislation was not authorized by "any * * * power in the constitutional provision concerning authors and inventors, and their writings and discoveries." *Id.* Instead, to come "within congressional control," trademark legislation must be authorized as an exercise of Congress' Commerce Clause authority. *Id.* at 95. The 1870 Act failed on that account, too, because, in

passing the Act, Congress made no effort to tie the regulation of trademarks to interstate, foreign, or Indian commerce.[9]

Over the next 75 years, Congress established limited protection for marks used in such commerce. *See* Pattishall, *supra*, at 461-462. But this legislation "reflected the view that protection of trademarks was a matter of state concern and that the right to a mark depended solely on the common law." *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985). Meaningful national trademark protection did not arrive until the passage of the Lanham Act in 1946. That "Act was intended to make 'actionable the deceptive and misleading use of marks' and 'to protect persons engaged in * * * commerce against unfair competition.' " *Two Pesos, Inc.* v. *Taco Cabana, Inc.*, 505 U.S. 763, 767-768 (1992) (quoting Act; footnote omitted). It affords "national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers." *Park 'N Fly*, 469 U.S. at 198. Because trademark law is not concerned with fostering innovation—or, as *The Trade-Mark Cases* establish, inventions within the domain of patent law—Lanham Act protection is renewable for as long as a holder continues to use his mark, "in perpetuity." *Qualitex Co.* v. *Jacobson Prods. Co.*, 514 U.S. at 164-165.

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[9] The Court observed that the common law recognized "[t]he right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons." 100 U.S. at 92. At the time of the founding, the English law of trademarks generally focused on "deceit, or the likelihood of deceit, arising out of a latecomer's use of a name or mark." Beverly W. Pattishall, *The Constitutional Foundations of American Trademark Law*, 78 Trademark Rptr. 456, 458 (1988). While the Framers were no doubt aware of this law, neither the Constitution nor any deliberation records make any mention of trademarks. *See id.* at 456.

The Lanham Act provides for registration with the PTO of trademarks—defined as "any word, name, symbol, or device, or any combination thereof" used by a producer "to indicate the source of [its] goods," 15 U.S.C. § 1127—and accords significant protection to such registered marks. *See id.* §§ 1114, 1057(b), 1065. But the Act also protects unregistered marks. In particular, Section 43(a) authorizes a civil action for the use by another of "any word, term, name, symbol, or device, or any combination thereof * * * which is likely to cause confusion * * * as to the origin, sponsorship, or approval of his or her goods." *Id.* § 1125(a). This Court has interpreted Section 43(a) to protect against the unauthorized use of another's trade dress, reasoning "that trade dress constitutes a 'symbol' or 'device' for purposes of the relevant sections." *Wal-Mart Stores, Inc.* v. *Samara Bros., Inc.*, 120 S. Ct. at 1342. In 1999 Congress amended Section 43(a) and, for the first time, expressly acknowledged "civil actions for trade dress infringement under this chapter for [unregistered] trade dress." 15 U.S.C. § 1125(a)(3).

Trade dress law—like trademark law in general—evolved from the law of unfair competition. Originally, the concept of trade dress, as the term suggests, "included only the packaging, or '*dressing*,' of a product." *Wal-Mart Stores*, 120 S. Ct. at 1342 (emphasis added). *See* Restatement (Third) of Unfair Competition § 16, cmt. a (1995). "[B]ut in recent years [the concept] has been expanded by many courts of appeals to encompass the *design* of a product," and even just its shape or configuration. 120 S. Ct. at 1342 (emphasis added). One commentator has traced this phenomenon to 1976, *see* Willajeanne F. McLean, *Opening Another Can of Worms: Protecting Product Configuration as Trade Dress*, 66 U. Cin. L. Rev. 119, 123 (1997) (citing *Truck Equip. Serv. Co.* v. *Fruehauf Corp.*, 536 F.2d 1210 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976)); another to the "early 1980s," 1 McCarthy, *supra*, § 8.1, at 8-2. But whenever it began, the notion of federal trade dress protection in a product's con-

figuration—*i.e.*, the article itself—is nascent compared with the public's right to copy from expired patents.[10]

The consequences of this phenomenon are far-reaching, and bring federal trademark law into direct conflict with patent law and the policies underlying that law. Quite unlike product packaging, labeling, or even ornamental design, there are typically only a finite number of configurations or shapes that a product may take. That is especially true in the case of a utility patented invention, made to perform a particular use or function. At the same time, cloaking product configurations with federal trade dress protection does not simply give the producer a tool to strengthen source identification of its product, but the perpetual right to use that configuration for as long as the producer likes, effectively—and indefinitely—taking the configuration out of the public domain. In the case of a patented invention, this result directly interferes with the constitutionally grounded and time-honored right of the public to copy and use the subject of expired patents. And, as explained next, there is no reason to conclude that Congress intended Section 43(a), or any other provision of the Lanham Act, to achieve that result.

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[10] *See also* 1 McCarthy, *supra*, § 8.1, at 8-2 to 8-3 (tracing the evolution of federal trade dress from packaging to products themselves). Not all lower courts have taken the last—or at least latest—leap in this judicial trend. *See, e.g., Leatherman Tool Group, Inc.* v. *Cooper Indus., Inc.*, 199 F.3d 1009, 1014 (9th Cir. 1999) ("overall appearance [of a product itself] is not protectable [under Section 43(a)] as trade dress, at least as against a competitor which clearly marks its own product with a distinct name and who uses distinct packaging"); *cf. Duraco Prods., Inc.* v. *Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1446-47 (3d Cir. 1994).

B. In Establishing A National Trademark Code, Congress Did Not Intend To Override The Public's Right To Copy From Expired Patents.

When Congress passed the Lanham Act, it did so against the backdrop of the decades, if not centuries, old understanding—grounded in the Constitution, patent laws, and this Court's own decisions—that the public has the right to copy and use the subject matter of expired patents. It must be presumed that Congress knew of that law. *See Bowen* v. *Massachusetts*, 487 U.S. 879, 896 (1988) ("the well-settled presumption [is] that Congress understands the state of existing law when it legislates"); *Goodyear Atomic Corp.* v. *Miller*, 486 U.S. 174, 184-185 (1988) ("We generally presume that Congress is knowledgeable about existing law pertinent to the legislation it enacts."). In fact, as far as the public's right to copy product configurations that are the subject of expired patents is concerned, there is reason to conclude that Congress specifically intended to incorporate the settled rule of decisions such as *Singer* and *Kellogg*.

One of the "purpose[s] of the Lanham Act was to codify and unify the common law of unfair competition and trademark protection." *Inwood Labs., Inc.* v. *Ives Labs., Inc.*, 456 U.S. 844, 861 n.2 (1982) (White J., concurring in result). As discussed, in *Singer* and *Kellogg* this Court ruled that—under our patent system—unfair competition and trademark protection may not defeat the public's right to copy a product configuration that is the subject of an expired patent. The Court reaffirmed that principle in *Scott Paper* on the eve of the passage of the Lanham Act. *See* 326 U.S. at 256. Those decisions shaped the common law that Congress sought to codify in the Lanham Act and, in particular, defined the outer limit of that law in the case of patented inventions. In codifying that law, the presumption is that Congress sought to bring the *Singer* rule with it. *See* Felix Frankfurter, *Some Reflections on the Reading of Statutes*, 47 Colum. L. Rev. 527, 537 (1947) (when a concept "is obviously transplanted

from another legal source, whether the common law or other legislation, it brings the old soil with it").

Nor is there any indication that in establishing national trademark protection, Congress sought to disrupt the "carefully crafted bargain" underlying the patent system. *Bonito Boats*, 489 U.S. at 150-151. As discussed above, and detailed by the Court in *Bonito Boats*, from the first Congress forward the "federal patent laws" have embodied that bargain and, thus, "create a federal right to 'copy and to use' " the subject of expired patents. *Id.* at 165. Extending federal trade dress protection to product configurations that are the subject of expired patents would deprive the public of the benefit of its bargain and effectively repeal that venerable federal right. Particularly given the absence of any express intent on the part of Congress to achieve that result, the Court should avoid construing the Lanham Act in a manner that would do so, unsettling the foundation of our patent system. *See County of Yakima* v. *Confederated Tribes & Bands of the Yakima Indian Nation*, 502 U.S. 251, 262 (1992) ("[I]t is a 'cardinal rule *** that repeals by implication are not favored.' ") (quotation omitted). *Accord Tennessee Valley Auth.* v. *Hill*, 437 U.S. 153, 189 (1978).

The evidence, in fact, is that Congress has never intended for the Lanham Act to intrude upon the Nation's patent system, or deprive the public of the fruits of that system. Thus, for example, in reporting on the bill that became the Lanham Act, the Senate Committee on Patents sought to defuse concern that the new federal trademark code would result in a collateral form of patent or copyright protection. The Committee wrote that "[t]his bill, as any other proper legislation on trade-marks, has at its object the protection of *trade-marks*, securing to the owner the good will of his business and protecting the public against spurious and falsely marked goods." S. Rep. No. 79-1333, at 3 (1946) (emphasis added). "This can be done," the Committee explained, "without any misgivings and without fear of

fostering hateful monopolies," for—unlike patent law—"no monopoly is involved in trade-mark protection." *Id.*

Consistent with this beginning, this Court itself has admonished that functional—or "useful," *Qualitex*, 514 U.S. at 165—product features are not entitled to trademark protection under Section 43(a). *See Two Pesos*, 505 U.S. at 775. Moreover, Congress recently amended Section 43(a) to provide that in an action for trade dress infringement, the plaintiff "has the burden of proving that the matter sought to be protected is *not* functional," 15 U.S.C. § 1125(a)(3) (emphasis added). As the Committee Report accompanying this amendment explains, "[f]unctional marks should be dealt with under the patent law." H.R. Rep. No. 106-250, at 7 (1999). Indeed, the Report goes on to observe that the amendment seeks to discourage owners of patents that are "about to expire" from attempting to register their invention as "a trademark, which receives protection as long as the owner uses it in commerce." *Id.* Cloaking the subject of an expired utility patent—such as MDI's dual-spring sign stand—with trade dress protection would frustrate Congress' express intent to reserve such protection for marks that are "*not* functional." 15 U.S.C. § 1125(a)(3) (emphasis added).[11]

This interpretation squares perfectly with patent law. A touchstone for utility patent protection is that the invention described in the patent must be "useful" or, at least in a lay sense, functional. 35 U.S.C. § 101. *See* Webster's II New University Dictionary 512 (1994) ("functional" means "[d]esigned for or adapted to a specific function or *use*") (emphasis added); Kevin E. Mohr, *At the Interface of Patent and Trademark Law: Should a Product Configuration Disclosed in a Utility Patent Ever Qualify for Trade Dress*

[11] Similarly, in the legislative history to the 1988 amendments of the Lanham Act, Congress indicated that it only intended Section 43(a) to apply to "nonfunctional configurations of goods." S. Rep. No. 100-515, at 40 (1988).

Protection?, 19 Hastings Comm. & Ent. L.J. 339, 380 n.161 (1997) ("Within the sphere of intellectual property law, the term 'functional' generally refers to shapes or features that have a utilitarian or 'useful' purpose.").[12] And the particular function, or use, to which a utility patented invention is dedicated will constrain the form it may take.

In interpreting the Lanham Act, this Court has always been careful to avoid conferring trademark protection on "useful product features." *Qualitex*, 514 U.S. at 164. *See Two Pesos*, 505 U.S. at 775. As the *Qualitex* Court admonished:

> It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§ 154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity). [514 U.S. at 164-165 (citations omitted).]

Thus, "even if customers have come to identify the special illumination-enhancing shape of a new patented light bulb with a particular manufacturer, the manufacturer may not use that shape as a trademark, for doing so, after the patent has

[12] The literal definition of "functional" squares with the manner in which the "usefulness" requirement has always been interpreted as a matter of patent law. *See, e.g., Besser* v. *Merrilat Culvert Core Co.*, 243 F. 611, 612 (8th Cir. 1917) ("The term 'useful,' as contained in the patent law, when applied to a machine, means that the machine will accomplish the purpose practically when applied in industry. It is to be given a practical and not a speculative meaning. It means that the machine will work and accomplish the purposes set forth in the specifications. * * * This has been the interpretation put upon the term in the patent law from the earliest decisions to the present time.") (citing cases).

expired, would impede competition * * * by frustrating competitors' legitimate efforts to produce an equivalent illumination enhancing bulb." *Id.* at 165. The same goes for the product configuration in the *Kellogg* case. *See id.* (citing *Kellogg* for the proposition that "trademark law cannot be used to extend monopoly over 'pillow' shape of shredded wheat biscuit after the patent for that shape had expired"). Here, MDI seeks to eliminate TrafFix's right to produce an equivalent sign stand to the one claimed in MDI's expired patents and practiced by it during the life of those patents. But trademark law does not extend to the form of that patented device either. *See also Inwood Labs.*, 456 U.S. at 864 ("imitation of a functional feature" is not actionable "under § 43(a)") (White, J., concurring in result).

As explained in Part III *infra*, some lower courts (including the Sixth Circuit below) have construed the concept of functionality so that it is possible for a product or its features to be functional in a literal sense—and, thus, be useful and meet the requirements of utility patent protection—but *not* in a legal sense due to factors extraneous to the product itself, such as the competitive need to imitate it. As a result, as applied by the lower courts, trademark's functionality doctrine has not safeguarded the public's right to copy and use a product configuration that is the subject of an expired patent. Indeed, in many instances—including the decision below—the functionality doctrine has been used to *frustrate* that right. The public's right to copy from expired utility patents should not be subordinated to this judge-made and counter-intuitive concept of "functionality." And nothing in the Lanham Act suggests that Congress intended that result.

Finally, Congress has repeatedly declined to expand protection for "industrial design." *Bonito Boats*, 489 U.S. at 167; *see Leatherman Tool Group*, 199 F.3d at 1012; 35 U.S.C. § 171. After recounting the numerous failed bills in this line, one court observed:

> We believe that courts should exercise restraint so as not to undermine Congress's repeated determinations not to afford virtually perpetual protection to product configurations with an expansive construction of section 43(a). What Congress has, for the great span of this century, been unwilling to do, should not be effected by the judiciary. [*Duraco Prods., Inc.* v. *Joy Plastics Enters., Ltd.*, 40 F.3d at 1447 (citation omitted).]

Affording trade dress protection for a product configuration that is the subject of an expired utility patent—and, thus, plainly utilitarian or functional in nature—would be even more out of step with Congress' reticence.

C. Construing The Lanham Act To Defeat The Public's Right To Copy From Expired Patents Would Raise Grave Constitutional Concerns.

There is an even more powerful force that counsels against construing Section 43(a) of the Lanham Act to reach a product configuration that is the subject of an expired utility patent: the Constitution itself. *See Jones* v. *United States*, 120 S. Ct. 1904, 1911 (2000) (where alternative construction is possible, Court should construe act to avoid constitutional problem); *Edward J. DeBartolo Corp.* v. *Florida Gulf Coast Bldg. & Constr. Trades Council*, 485 U.S. 568, 575 (1988). As discussed, the Patent Clause expressly—and quite purposefully—provides that Congress may only grant exclusive rights in discoveries for "limited Times." U.S. Const. art. I, § 8, cl. 8. Thus, "Congress may not create patent monopolies of unlimited duration." *Bonito Boats*, 489 U.S. at 146. Congress may not do so directly by issuing patents of unlimited duration and—as this Court's decisions establish—it may not do so indirectly by cloaking the subject of expired patents with perpetual trademark protection.

In the *Singer* line, this Court repeatedly recognized that extending trademark or unfair competition protection to product configurations that are the subject of expired patents

has precisely this effect, and that this result impermissibly interferes with the "federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leaves in the public domain." *Compco*, 376 U.S. at 237. In *Scott Paper*, moreover, the Court—citing *Singer* and *Kellogg*—declared that a "patentee may not * * * secure, to any extent, a continuation of his monopoly by resorting to trademark law," because "any attempted reservation or continuation in the patentee * * * of the patent monopoly, after the patent expires, *whatever the legal device employed*, runs counter to the policy and purpose of the patent laws." 326 U.S. at 256 (emphasis added). The same conclusion follows when the "legal device" employed to achieve this result is the law of federal trade dress.

Of course, this Court has also recognized that—short of "substantially restricting the public's ability to exploit ideas that the patent system mandates shall be free for all to use," *Bonito Boats*, 489 U.S. at 167—legislatures may protect against consumer confusion and seek to promote competition by, *inter alia*, requiring producers to label or package their goods in a particular fashion. *See id.* at 165; *Kellogg*, 305 U.S. at 120-121.[13] But especially when a product is the

[13] Similarly, in *Kewanee Oil Co.* v. *Bicron Corp.*, *supra*, the Court held that the patent laws and policies do not preclude trade secret protection for the subject of patents. As the Court recognized, however, the public's right to copy and use information in the public domain is not frustrated by such laws, since, "[b]y definition, a trade secret has not been placed in the public domain." 416 U.S. at 484 (footnote omitted). Moreover, "trade secret law does not forbid the discovery of the trade secret by fair and honest means, *e.g.*, independent creation or reverse engineering." *Id.* at 490. In addition, "[t]rade secret law and patent law have coexisted in this country for over one hundred years." *Id.* at 493. By contrast, this Court has for at least a century emphasized that trademark or unfair competition law must yield to patent law in the case of a product configuration covered by an expired patent. *Cf. Aronson* v. *Quick Point Pencil Co.*, 440 U.S. 257, 266 (1979) ("Enforcement of this royalty agreement is even less offensive to federal patent policies than state law protecting trade secrets.").

subject of an expired patent, a legislature may not "prohibit the copying of the *article itself*." *Sears*, 376 U.S. at 232-233 (emphasis added). That would result in the sort of perpetual patent monopoly the Framers expressly sought to preclude. In *Bonito Boats*, the Court reaffirmed this principle when it observed that the statute at issue there, "[i]n essence, * * * prohibit[ed] the entire public from engaging in a form of reverse engineering of a product in the public domain." 489 U.S. at 160. That result impermissibly "restrict[ed] the public's ability to exploit" a product configuration within the public domain. *Id.* at 167.

So too here. Indeed, MDI has attempted to make a great deal out of the fact that "TrafFix imitated the 'WindMaster' configuration by sending it to Korea to be copied or 'reverse engineered,' " Opp. 2, and is essentially suing to prevent its competition from copying its dual-spring sign stand in the same fashion. But, as this Court has observed, and the *Bonito Boats* Court plainly appreciated, reverse engineering is a "*fair and honest* means" of "discovery." *Kewanee Oil*, 416 U.S. at 476 (emphasis added). What is more, it often leads to "significant advances in technology." *Bonito Boats*, 489 U.S. at 160. This case proves the point. After reengineering MDI's sign stand, TrafFix made—and patented—significant improvements to that sign stand. *See supra* at 6. The Framers appreciated the virtues of such imitation and, thus, sought to guarantee a patent system in which it would be allowed and indeed encouraged. These virtues have not been lost upon this Court. *See Bonito Boats*, 489 U.S. at 146 ("[I]mitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy.").

Despite all this, MDI argues that the *Singer* line can be explained away on the ground that "none of the Court's opinions confronted the federal patent law vis-à-vis the federal trademark law." Opp. 6. This distinction does not withstand scrutiny. As Judge Cudahy put it, "[t]he *conflict* posed by the[] state laws [in the *Singer* line] and the Lanham Act remains the same: whether trademark can be used as a back door to protection properly acquired by a * * * patent." *Kohler Co.* v. *Moen Inc.*, 12 F.3d 632, 647 (7th Cir. 1993) (dissenting) (emphasis in original). The Court has repeatedly answered that question in the negative. *See* Part I.B, *supra*; *see also I.P. Lund Trading ApS* v. *Kohler Co.*, 163 F.3d 27, 53 (1st Cir. 1998) ("Giving patent-like protection a new name does not avoid constitutional limitations.") (Boudin, J., concurring) (citing *Bonito Boats*, 489 U.S. at 146). That conclusion cannot depend on whether state or federal trademark law is invoked to achieve such "back door" protection.

Congress is no more free to use trademark law as a means of extending the patent monopoly than are the States. The Lanham Act is a product of Congress' Commerce Clause authority, not its patent power. While potent, the Commerce Clause does not empower Congress to override the express limits in other parts of the Constitution. *See* U.S. Const. art. I, § 8, cl. 3; *College Sav. Bank* v. *Florida Prepaid Postsecondary Educ. Expense Bd.*, 119 S. Ct. 2219, 2224 (1999); *see also Gibbons* v. *Ogden*, 22 U.S. (9 Wheat) 1, 196 (1824) (Commerce Clause "power, like all others vested in Congress, is complete in itself, may be exercised to its utmost extent, and acknowledges no limitations, *other than are prescribed in the Constitution*.") (Marshall, C.J.) (emphasis added); *North American Co.* v. *SEC*, 327 U.S. 686, 704-705 (1946) (Commerce Clause power "is limited by express provisions in other parts of the Constitution"). Thus, in establishing trade dress protection under Section 43(a), the Commerce Clause does not empower Congress to establish what are, in essence, patent monopolies of unlimited times.

Of course, as explained, the evidence is that in conferring federal trademark protection, Congress has specifically sought to avoid this result. That is all the more reason for this Court to avoid construing the Lanham Act in a manner that would create this constitutional conflict.

III. THE PUBLIC'S RIGHT TO COPY FROM EXPIRED PATENTS SHOULD NOT BE SUBORDINATED TO A FACTBOUND, "COMPETITIVE NEED" INQUIRY.

Some lower courts—including the Sixth Circuit below—have relegated the public's right to copy a product configuration that is the subject of an expired patent to a finding of "competitive necessity." Pet. App. 20a.[14] This is done under the guise of "functionality": "[i]f competitors need to be able to use a particular configuration in order to make an equally competitive product, it is [deemed] functional, but if they do not, it may be nonfunctional." *Vornado Air Circulation Sys., Inc.* v. *Duracraft Corp.*, 58 F.3d at 1507. "[U]sefulness in the patent context does not equal functionality in the trademark context"; instead, functionality turns solely on "competitive need." *Zip Dee, Inc.* v. *Dometic Corp.*, 931 F. Supp. 602, 608 (N.D. Ill. 1996). *See* Todd R. Geremia, *Protecting the Right to Copy: Trade Dress Claims for Configurations in Expired Utility Patents*, 92 Nw. U. L. Rev. 779, 781, 801-802 (1998). Under this regime, every patented device potentially qualifies for trade dress protec-

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[14] According to the Sixth Circuit: "The appropriate question is whether the particular product configuration is a competitive necessity. If it affects the cost or the quality or the objective (non-reputational) desirability of competitors' products negatively enough, then the trade dress element may be deemed legally functional." Pet. App. 20a. *See also, e.g., Thomas & Betts Corp.* v. *Panduit Corp.*, 138 F.3d 277, 297 (7th Cir.) ("to be functional in the trade dress sense, the feature must be necessary to afford a competitor the means to compete effectively") (quotation omitted), *cert. denied*, 525 U.S. 929 (1998).

tion, and the same device "can switch back and forth between being functional and nonfunctional with the vagaries of the marketplace." *Vornado*, 58 F.3d at 1510 n.20.

The public's constitutionally-based right to copy from expired patents should not be subordinated to this indeterminate, judge-made inquiry. The functionality doctrine was developed by courts to *prevent* trademark law from intruding on the "province of patent law." *Qualitex*, 514 U.S. at 164. Invoking the doctrine to defeat one of the key features of patent law—the public's right to copy from expired patents—turns that purpose on its head. More to the point, it results in the very constitutional problem discussed in the preceding section: perpetual rights in useful arts. Nothing in the Constitution, this Court's decisions, or the history of our patent system suggests that the patent monopoly may be indefinitely extended for a product, or that the public's right to copy from expired patents may be frustrated, simply because of a judicial finding that there is no "competitive need" for the public to enjoy the fruits of a particular discovery, at a particular point in time, in a particular market.

Quite the contrary. For at least a century, this Court has treated the expiration of the patent as determinative of the public's "right to make the thing formerly covered by the patent." *Singer*, 163 U.S. at 185. *See Bonito Boats*, 489 U.S. at 151 ("upon expiration of [a patent], the knowledge of the invention inures to the people, who are thus enabled *without restriction* to practice it and profit by its use") (quotation omitted; emphasis added). If anything, the Framers—and above all Jefferson—were only more resolute when it came to ensuring that the public would be able to benefit from discoveries as soon as their limited patent protection lapsed. *See supra* at 13-14. And thus, in crafting our Constitution, the Framers sought to ensure that "exclusive Right[s]" in discoveries—whether dressed in patent, trademark, or some other terms—would be available only for "limited Times." U.S. Const. art. I, § 8, cl. 8. Not for potentially *unlimited*

times, depending on a judicial finding of a purported lack of competitive need to copy and use a particular discovery.

Nothing in this Court's trademark decisions support equating functionality solely with competitive need. Instead, the Court has said that the purpose of the "functionality doctrine" is to prevent trademark law from "allowing a producer to control a *useful* product feature." *Qualitex*, 514 U.S. at 164 (emphasis added). By definition, a product that is the subject of a utility patent is just that—"useful." 35 U.S.C. § 101. Similarly, the Court has stated that "a product feature is functional, and cannot serve as a trademark, if it is essential to the *use or purpose* of the article *or* if it affects the cost or quality of the article, that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage." *Qualitex*, 514 U.S. at 165 (quoting *Inwood Labs.*, 456 U.S. at 850 n.10; emphases added). As a practical matter, a product feature will not qualify for utility patent protection unless it is "essential to the use and purpose of the article." *Id.*; *see supra* at 31 & n.12.[15]

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[15] The disjunctive used by the *Qualitex* Court squares with how commentators have characterized the functionality doctrine. For example, according to Professor McCarthy, "there are two rationales underlying the functionality bar: (1) accommodation to the principle that there is only one legal source of exclusive rights in utilitarian features—utility patent law; and (2) preserving free and effective competition by ensuring that competitors can copy features that they need to 'compete effectively.' " 1 McCarthy, *supra*, § 7:68, at 7-147. Both definitions are "relevant and useful in determining whether the policies of free competition dictate that a given feature should be a candidate for the right to exclude that is given by trade dress law." *Id.* at 7-148. In product configuration trade dress cases, however, courts have erred by focusing only on the second rationale. A product configuration that is the subject of "an engineering-driven utilitarian design" disclosed in a "utility patent" meets the first definition and, thus, is functional in the trademark sense, without regard to whether it also satisfies the second definition. *Id.* at 7-150. The spiral fan at issue in the Tenth

At the same time, this Court has never applied the functionality doctrine to defeat the public's right to copy from an expired patent. Instead, it has invoked the doctrine to determine whether unpatented or unpatentable features—*e.g.*, color (*Qualitex*)—qualify for trademark protection. *Cf. Inwood Labs.*, 456 U.S. at 857-858 n.20 (discussing "functionality" of drug "capsule colors"). Whatever the virtues of applying the functionality doctrine to such unpatented or unpatentable product features, it should not be invoked to extend trademark protection to a product configuration that has qualified for and enjoyed utility patent protection. As the *Qualitex* Court itself admonished: "It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. § § 154, 173, *after which competitors are free to use the innovation.*" 514 U.S. at 164 (emphasis added). The *Qualitex* Court's parenthetical citation to the *Kellogg* case and its light bulb example only reinforce that conclusion. *See id.* at 165.

There are compelling practical reasons for not subjecting the public's right to copy to a competitive-need based, "functionality" test. This inquiry is multi-faceted, highly factbound, and, thus, scarcely amenable to summary disposition. *See Kohler Co.* v. *Moen Inc.*, 12 F.3d at 649 ("The line between nonfunctional and functional [under this approach] is difficult to draw and an obvious source of litigation.") (Cudahy, J., dissenting); 1 McCarthy, *supra*, § 7:73, at 7-166.1 ("Each case of alleged functionality will present a unique set of facts not easily disposed of either by sweeping generalities or precise legal rules."); Mohr, *supra*, at 386-387 n.186 (commentators have "criticized this focus on competi-

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Circuit *Vornado* case meets this utilitarian definition, as does the "new patented light bulb" discussed by this Court in *Qualitex*. *See id.* at 7-150; *id.* § 7:69, at 7-152 n.3. The same goes for the patented dual-spring sign stand at issue here.

tive effect as largely unworkable").[16] As this case illustrates, moreover, "competitive need" is often in the eye of the beholder. The District Court below found that cloaking MDI's sign stand with trade dress protection would hinder competition, *see* Pet. App. 53a-55a, 65a, whereas the Court of Appeals had a different take, *see id.* 20a-21a. On remand, a jury likely would have the final say, but only after "the gathering of substantial amounts of data and the expensive testimony of experts." Mohr, *supra*, at 426.[17]

This inquiry, in short, is a recipe for uncertainty, litigation, and, just as potent, the plausible threat of litigation. *See Grubart* v. *Great Lakes Dredge & Dock Co.*, 513 U.S. 527, 547 (1995) ("the open-ended rough-and-tumble of factors * * * invites complex argument in a trial court and a virtually inevitable appeal"). As one commentator has explained, under this approach, "a patentee's competitors have good

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[16] While arguing for application of this broader concept of functionality, the International Trademark Association recognizes that this inquiry is "complex[]," turns on "application of various multi-factored tests," is subject to "no universal standard," and requires consideration of factors such as "advertising," "economies of manufacture," and even "the plaintiff's intent." ITA Br. 16-17. That is hardly a workable standard, if a "standard" at all.

[17] In conducting this "functionality" inquiry, the lower courts have ascribed different weights to the fact that the product configuration at issue is the subject of an expired utility patent, ranging from great weight, *e.g.*, *Disc Golf Ass'n* v. *Champion Discs, Inc.*, 158 F.3d 1002, 1006 (9th Cir. 1998); to some weight, *e.g.*, *Thomas & Betts Corp.* v. *Panduit Corp.*, 138 F.3d at 289; to *no* weight, *e.g.*, Pet. App. 19a (District Court should have applied "a functional analysis of the trade dress *unencumbered by any presumptions*" stemming from the expired patent) (emphasis added). While a "great weight" approach is more defensible than a "no weight" approach, the public's right to copy from expired patents should not be reduced to a multi-factored inquiry in which the touchstone is competitive need and the existence of an expired patent is just a factor in the mix.

reason to doubt whether they are entitled to reproduce a formerly patented invention as it is disclosed in the specifications of a utility patent. Currently, before replicating configurations disclosed in expired utility patents, competitors must consult with the 'vagaries of the marketplace' to ascertain whether the configuration is functional" and, thus, subject to imitation. Geremia, *supra*, at 816 (quoting *Vornado*, 58 F.3d at 1510 n.20). After doing so, in most cases competitors, even with the assistance of legal counsel, would only be able to hazard a *guess* as to whether copying a product configuration covered by an expired patent would subject them to liability under the Lanham Act. Moreover, it would be impossible to rule out costly litigation resulting from competitors seeking to prolong their patent monopolies under the law of federal trade dress.

The Court has recently acknowledged the stifling effect on competition of such a litigation petri dish. *See Wal-Mart Stores*, 120 S. Ct. at 1345 ("Competition is deterred * * * not merely by successful suit but by the plausible threat of successful suit."). The effect here is particular unsettling, for "imitation and refinement through imitation" is "the very lifeblood of a competitive economy." *Bonito Boats*, 489 U.S. at 146. *See Moen Inc.*, 12 F.3d at 651 ("The right to copy * * * is absolutely essential to the successful long-term operation of a free and competitive economy.") (Cudahy, J., dissenting). Indeed, recognizing trade dress protection for the subject of expired utility patents—contingent on the outcome of a factbound, competitive-need test—would be like unleashing "a loose canon on the decks of the good ship 'Free Competition.'" J. Thomas McCarthy, *Lanham Act § 43(a): The Sleeping Giant Is Now Wide Awake*, 59 Law & Contemp. Probs. 45, 64 (1996).[18]

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[18] *See also Thomas & Betts Corp.* v. *Panduit Corp.*, 935 F. Supp. 1399, 1408-09 (N.D. Ill. 1996) ("If a prospective competitor must face the threat of Lanham Act litigation for 'slavishly copying' the invention, * * * [c]ompetitors would be hesitant to take advantage of inventions coming off patent for fear that the holders of the expired utility patent will argue, as they do here, that their product has gained secondary meaning and is protected by the Lanham Act."), *rev'd*, 138 F.3d 277 (7th Cir. 1998).

Competition is not all that will suffer. By discouraging imitation of patented inventions, the "plausible threat of successful suit" (*Wal-Mart Stores*, 120 S. Ct. at 1345) will stagnate the progress of useful arts. As Justice Story observed long ago, the "best" way to promote the useful arts is "by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible." *Pennock* v. *Dialogue*, 27 U.S. (2 Pet.) at 19. This belief—embodied in the Patent Clause—has not fallen out of favor. *See Bonito Boats*, 489 U.S. at 146 ("refinement through imitation" is "necessary to invention"); *id.* at 160 ("Reverse engineering of * * * mechanical articles in the public domain often leads to significant advances in technology."). In this regard, the march of scientific and technological advancement in this country is perhaps the greatest reason of all for not tinkering with the system that our Constitution, patent laws, and this Court's own precedents establish and so carefully guard.

All this counsels in favor of adopting a clear, predictable rule—and this Court already has done so: "after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public as a matter of federal law." *Bonito Boats*, 489 U.S. at 152. As cases such as *Singer* and *Kellogg* establish, that "subject matter" includes "the form in which [the device] was constructed during the patent." *Singer*, 163 U.S. at 185. It also includes the invention described or claimed in the patent. This redirects the focus from the indeterminate concept of competitive need to the patent itself. The patent system "provides a ready means of discerning the status of the intellectual property embodied in an article of manufacture or design." *Bonito Boats*, 489 U.S.

at 162. Indeed, its disclosure requirements are specifically designed to ensure that the public is apprised of the scope of the patent. *See Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) ("It has long been understood that a patent must describe the exact scope of an invention and its manufacture to secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them.") (citation omitted); *supra* at 16.[19]

This approach is a far more desirable—not to mention constitutionally grounded and time tested—means of protecting the patent bargain and the public's right to copy from expired patents. At the same time, Congress has other means to protect against consumer confusion caused by the similarity in goods. For example, it may require producers to identify their products with "trademarks, labels, or distinctive dress in the packaging of goods so as to prevent others, by imitating such markings, from misleading purchasers as to the source of goods." *Sears*, 376 U.S. at 232. *Cf. Versa Prods. Co.* v. *Bifold Co. (Mfg.) Ltd.*, 50 F.3d 189, 203 (3d Cir.) ("clarity of labeling in packaging and advertising will suffice to preclude almost all possibility of consumer confusion as to source stemming from the product's configuration"), *cert. denied*, 516 U.S. 808 (1995). This is the conventional stuff of trademark law, far removed from the recently minted concept of "product configuration trade dress" in the subject of expired utility patents.

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[19] Patent law also polices the designation of goods as patent protected. *See* 35 U.S.C. § 292. In this regard, a producer such as MDI that labels its product as covered by a patent during the life of the patent should hardly be permitted to take a contrary position—for trade dress purposes—once the patent expires. The same goes for any representations made to the PTO in order to obtain patent protection in the first place. *See* Pet. App. 49a.

CONCLUSION

For the foregoing reasons, the judgment below should be reversed.

Respectfully submitted,

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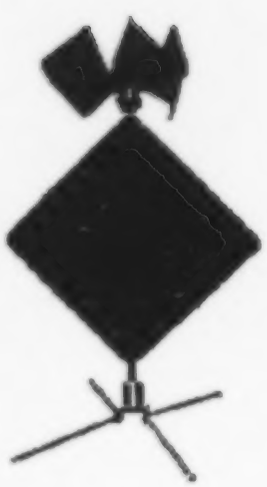
APPENDIX

BEST AVAILABLE COPY

DUAL-SPRING TRAFFIC SIGN STANDS



MDI

TrafFix

Winn-Proof

[Reply Br. for Appellant Cross-Appellee, 6th Cir. Nos. 97-1148, 2096, 2097, at 21.]

STATUTORY ADDENDUM

15 U.S.C. § 1125 provides in part:

§ 1125. False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

35 U.S.C. § 101 provides:

§ 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 102 provides:

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c)

of this title before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference (conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. § 103 provides in part:

§ 103. Conditions for patentability; non-obvious subject matter

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

* * *

(c) Patentability shall not be negatived by the manner in which the invention was made. Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time

the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 112 provides in part:

§ 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. § 154 provides in part:

§ 154. Contents and term of patent

(a) In general.—

(1) Contents.—Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.

(2) Term.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120,

121, or 365(c) of this title, from the date on which the earliest such application was filed.

(3) Priority.—Priority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent.

(4) Specification and drawing.—A copy of the specification and drawing shall be annexed to the patent and be a part of such patent.

35 U.S.C. § 171 provides:

§ 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.